

Appl. No. 09/517,127

Response to Office Action mailed 9/8/2005

REMARKS

Applicants greatly appreciate the recognition of patentable subject matter in the present application.

Applicants hereby add new claims 169-181 and cancel claims 8-9, 29, and 40 . Accordingly, claims 1-5, 10-20, 22-28, 31-33, 39, 41-65, 67, 130-131, 133-135, 138-144, and 152-181 are pending in the present application.

Claims 1-5, 8-9, 11-20, 22-26, 39, 46-48, 58-64, 67, 130-131, 133-135, 138-142, 144, 154-168 stand rejected under 35 USC 102(e) for anticipation by U.S. Patent No. 5,791,970 to Yueh et al.

Applicants respectfully traverse the rejections and urge allowance of the present application.

Referring to independent claim 1, the system comprises a sensor configured to monitor turbidity of a process fluid. At page 2 of the Action, the Office baldy alleges that the sensor of Yueh is configured to monitor turbidity as claimed since particle size distribution measurements inherently measure the accumulation of particles and thus turbidity. Yueh fails to disclose any teachings regarding turbidity and the reliance upon inherency is improper.

Initially, Applicants have electronically searched Yueh and **have failed to uncover any teaching regarding turbidity**. To properly rely upon inherency, *the Office must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied prior art.* *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). The Action

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is void of any basis in fact or technical reasoning to support the bald allegation that particle size distribution measurements inherently measure the accumulation of particles and thus turbidity. It has not been demonstrated that information regarding turbidity necessarily flows from information provided by particle size distribution sensor 31 of Yueh. The Office has failed to provide any basis or reasoning as to why a particle size distribution sensor is considered to measure accumulation of particles or why turbidity is monitored thereby. Furthermore, inasmuch as Yueh is void of any reference to turbidity, it is non-sensical to assert that the limitations regarding inherency necessarily flow from the teachings of Yueh. Limitations of claim 1 are not disclosed by the prior art and claim 1 is allowable over the prior art.

Applicant respectfully requests issuance of a non-final Action if the rejection of claim 1 is not withdrawn. More specifically, the Office has failed to provide the necessary basis in fact or technical reasoning to support a reliance upon inherency. Applicants respectfully request identification *in a non-final action* of the basis in fact or technical reasoning in accordance with 37 C.F.R. §1.104(c)(2). In particular, 37 C.F.R. §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified*. Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. *When a reference is complex or shows or describes inventions other than that claimed by Applicants, the particular teachings relied upon must be designated as nearly as practicable*. Applicants respectfully request clarification of the rejections with respect to specific references and specific reference teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a non-final Action if claim 1 is not

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found to be allowable.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, referring to dependent claim 2, the tank 29 of Yueh is not disclosed as a sampling system and is not configured to provide the process fluid in a substantially static state inasmuch as the tank is clearly disclosed as a recycle tank and the recycled slurry is mixed with new slurry at col. 3, lines 5+ using the mixer 42. Claim 2 is allowable for these additional reasons.

Referring to dependent claim 3, no basis in fact or technical reasoning is provided in support of the reliance upon inherency and the rejection is improper for at least this reason.

Referring to independent claim 18, Yueh fails to disclose or suggest any teachings regarding turbidity and sensor 31 providing particle size information does not and has not been demonstrated to inherently provide information regarding turbidity. Positively-recited limitations of claim 18 including outputting a signal indicative of turbidity are not disclosed nor suggested by the prior art and claim 18 is allowable for at least this reason.

The claims which depend from independent claim 18 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to independent claim 39, the system recites limitations of claim 40 indicated by the Office to be allowable. Claim 39 is believed to be in condition for

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allowance.

The claims which depend from independent claim 39 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to independent claim 58, Fig. 2 of Yueh discloses a continuous recycling system for recycling slurry using funnel 24, tube 26, tank 29 and conduit 33. Applicants have failed to uncover any teachings in Yueh of the claimed *drain coupled to the connection and configured to remove at least a portion of the process fluid from the system responsive to a signal from the sensor* as positively claimed. Positively recited limitations of claim 58 are not disclosed nor suggested by the prior art and claim 58 is allowable for at least this reason.

Furthermore, the Office fails to identify teachings of Yueh which allegedly disclose the claimed drain and accordingly a non-final Action is proper in accordance with the C.F.R. if claim 58 is not allowed.

The claims which depend from independent claim 58 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to independent claim 63, the sensor of Yueh is not disclosed as being configured to monitor turbidity as positively claimed. In addition, Applicants traverse any reliance upon inherency and submit the Office has failed to establish that the turbidity limitations necessarily flow from the teachings of Yueh as required for proper reliance upon inherency. Claim 63 is allowable.

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The claims which depend from independent claim 63 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 130, Yueh is void of disclosing or suggesting the connection configured to provide the process fluid in a substantially static state, the control system configured to compare the substantially static process fluid with a signature, or the control system configured to control a flow rate of process fluid responsive to the comparison. To the contrary, tank 29 comprising sensor 31 and stirring mechanism 42 is configured to agitate the slurry. Limitations of claim 130 are not disclosed nor suggested by the prior art and claim 130 is allowable for at least this reason.

The claims which depend from independent claim 130 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 133, the Yueh fails to disclose or suggest a flush system coupled with the connection and configured to selectively flush the connection with a rinse fluid different than the process fluid used to process the workpieces. Claim 133 is allowable.

The claims which depend from independent claim 133 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 138, Yueh fails to disclose or suggest the claimed sensor configured to output a signal indicative of turbidity of the process fluid as positively claimed. In addition, Applicants traverse any reliance upon inherency and submit the Office has

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failed to establish that the turbidity limitations necessarily flow from the teachings of Yueh as required for proper reliance upon inherency. Claim 138 is allowable.

The claims which depend from independent claim 138 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 139, Yueh fails to disclose or suggest the claimed sensor configured to output a signal indicative of turbidity of the process fluid as positively claimed. In addition, Applicants traverse any reliance upon inherency and submit the Office has failed to establish that the turbidity limitations necessarily flow from the teachings of Yueh as required for proper reliance upon inherency. Additionally, Yueh fails to disclose or suggest the *control system configured to control a recirculation system to recirculate the process fluid responsive to the turbidity of the process fluid being out of specification* as defined in claim 139. Claim 139 is allowable.

Referring to claim 140, the sensor of Yueh is not disclosed as being configured to monitor turbidity and Yueh fails to disclose or suggest the claimed sensor configured to monitor turbidity as positively claimed. In addition, Applicants traverse any reliance upon inherency and submit the Office has failed to establish that the turbidity limitations necessarily flow from the teachings of Yueh as required for proper reliance upon inherency. Claim 140 is allowable.

The claims which depend from independent claim 140 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

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Referring to claim 141, the sensor of Yueh is not disclosed as being configured to monitor turbidity and Yueh fails to disclose or suggest the claimed sensor configured to monitor turbidity as positively claimed. In addition, Applicants traverse any reliance upon inherency and submit the Office has failed to establish that the turbidity limitations necessarily flow from the teachings of Yueh as required for proper reliance upon inherency. Claim 141 is allowable.

Referring to claim 142, the sensor 31 of Yueh is configured to monitor the entirety of the slurry present within tank 29 and is not configured to *output a signal indicative of one of the components of the process fluid* as positively claimed. Further, Yueh fails to disclose or suggest the control system controlling mixing of the components responsive to the signal indicative of one of the components of the process fluid. Claim 142 is allowable.

Referring to claim 144, the sensor of Yueh is not disclosed as being configured to monitor turbidity and Yueh fails to disclose or suggest the claimed sensor configured to monitor turbidity as positively claimed. In addition, Applicants traverse any reliance upon inherency and submit the Office has failed to establish that the turbidity limitations necessarily flow from the teachings of Yueh as required for proper reliance upon inherency. Claim 144 is allowable.

The claims which depend from independent claim 144 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 163, the sensor of Yueh is not disclosed as being configured to monitor turbidity and Yueh fails to disclose or suggest the claimed sensor configured to

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monitor turbidity as positively claimed. In addition, Applicants traverse any reliance upon inherency and submit the Office has failed to establish that the turbidity limitations necessarily flow from the teachings of Yueh as required for proper reliance upon inherency. Yueh fails to disclose or suggest the connection configured to provide the process fluid in a substantially static state or the control system configured to compare the substantially static process fluid with the signature as claimed. Claim 163 is allowable for at least the above-mentioned compelling reasons.

The claims which depend from independent claim 163 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 165, the sensor of Yueh is not disclosed as being configured to monitor turbidity and Yueh fails to disclose or suggest the claimed sensor configured to monitor turbidity as positively claimed. In addition, Applicants traverse any reliance upon inherency and submit the Office has failed to establish that the turbidity limitations necessarily flow from the teachings of Yueh as required for proper reliance upon inherency. Claim 165 is allowable.

The claims which depend from independent claim 165 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 168, the sensor of Yueh is not disclosed as being configured to monitor turbidity and Yueh fails to disclose or suggest the claimed sensor configured to monitor turbidity as positively claimed. In addition, Applicants traverse any reliance upon

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inherency and submit the Office has failed to establish that the turbidity limitations necessarily flow from the teachings of Yueh as required for proper reliance upon inherency. Claim 168 is allowable.

Applicants hereby add new claims 169-178 which are supported at least by page 9, lines 1+ of the originally filed specification.

New claim 179 includes the limitations of previously pending claim 39 and dependent claim 43 indicated to recite allowable subject matter and accordingly new claim 179 is believed to be in condition for allowance.

Applicants respectfully request allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

Dated: 1/9/06

By: 

James D. Shaurette

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